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EXAMINER

LACLAIR, DARCY D

ART UNIT

PAPER NUMBER

1796

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Attachment to Advisory Action

Applicants' amendment filed **2/4/2009** has been fully considered; however, the amendment has not been entered given that it is not in compliance, it introduces the issue of new matter and raises other new issues that would require further consideration and/or search.

Support for the amendments to **Claims 1 and 3** is acknowledged on page 21, line 24-26, page 26, line 8-13, and page 27, line 21-24.

With respect to other new issues, **claims 1 and 3** have been amended to recite that the sealant systems to be rendered thixotropic by the silica and the time for incorporation to be reduced relative to silica which has not been compacted with a roller compactor or a pressing filter belt. It is the examiner's position that this is a new issue since the scope of the claims has been changed. Therefore, the amendment would require further consideration and/or search.

In the interest of better enabling the applicants to assess the patentability of their claims, the following advisory is given:

Had the amendment been entered:

The **35 USC 112**, 1st paragraph would have been withdrawn.

Claim 1 would have been objected to because the resins is(are) not properly claimed in the alternative. It recites "any of" a group of resins linked by "and." In order to claim a group using Markush language, this should be "or." Alternatively, one acceptable form of alternative expression, recites members as being "selected from the

Art Unit: 1796

group consisting of A, B and C.” See *Ex parte Markush*, 1925 C.D. 126 (Comm’r Pat. 1925) See MPEP § 2173.05(h).

The **35 USC 102** rejection of the claims over **Nowak et al. (US 2005/0232556)** would be maintained. Nowack teaches the incorporation of Aerosil R202 VV60 and VV90, which are silicas consistent with applicant’s compacted silicas, into polyurethane and other polymers to confer a thixotropic effect. The examiner notes that this rejection was not addressed in the remarks filed with the Amendment After Final filed on 2/4/2009.

The **35 USC 102** rejection over **Hartmann et al. (US 5,959,005)** would be withdrawn in light of the addition of the features of thixotrophy and reduction of time to the amended claims, however the **35 USC 103** rejection would be maintained. The examiner notes that the silica has been recited in ***product-by-process*** format, which is not given patentable weight absent a showing of criticality. While the Hartman reports a low thickening effect during mixing, (see col 2 line 3-8) this is not inconsistent with applicant's teachings, which require thixotrophy. The composition would therefore be expected to have a low thickening effect during mixing. Hartmann still, therefore, renders the amended claims obvious. Hartmann teaches that the silica makes possible a high degree of filling because of the low thickening action, which is consistent with improving mixing, which would reduce the time required for mixing of a given quantity of silica. (See col 2 line 3-8)

The **35 USC 102** rejection over **Meyer et al. (US 2002/0077388)** would be maintained. The examiner notes that the silica has been recited in ***product-by-***

Art Unit: 1796

process format, which is not given patentable weight absent a showing of criticality.

Hartmann still, therefore, renders the amended claims obvious. Additionally, the viscosity with Aerosil R8200 appears to be significantly higher at slow mixing speeds (6 rpm) than at high mixing speeds (60 rpm). (See Table 2) This is a thixotropic effect. The decrease in viscosity would render mixing and incorporation easier, and this would reduce the time required to achieve incorporation.

The **35 USC 102** rejection over **Adams et al. (US 7,144,930)** would be withdrawn in light of the addition of the features of thixotrophy and reduction of time to the amended claims. The examiner notes that the silica has been recited in **product-by-process** format, which is not given patentable weight absent a showing of criticality.

The examiner notes that there is a typographical error in the headers of the documents sent by applicant. The application number is listed as 10/95853. This should be 10/595853.

2/13/2008

Darcy LaClair

/D. D. L./

Examiner, Art Unit 1796

/Vasu Jagannathan/

Supervisory Patent Examiner, Art Unit 1796